

This Opinion is Not a
Precedent of the TTAB

Mailed: July 11, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Laramie Dorris

Serial No. 88901984
—

Clay McGurk of The Law Office of Clay McGurk
for Laramie Dorris.

Christina M. Riepel, Trademark Examining Attorney, Law Office 124,
Lydia Belzer, Managing Attorney.

—
Before Wellington, Goodman and Heasley
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Laramie Dorris (“Applicant”) seeks registration on the Principal Register of the standard-character mark **JUST GYDDIUP** for “hats; shirts” in International Class 25.¹

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the commonly-owned registered marks **GiddyUp Boots** (in standard characters) and

¹ Application Serial No. 88901984; filed May 5, 2020, based on an allegation of a bona fide intent to use the mark under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).



, both registrations for “boots” in International Class 25 with a disclaimer of “boots.”²

Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration. The appeal is fully briefed. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is argument and evidence. *See In re Guild Mortg. Co.*, 912 F.3d

² Registration Nos. 5890652 (standard character mark) and 5890658 (stylized with design) issued on October 22, 2019 to Brittany Birkhauser, an individual. The latter mark is described in the registration as “consist[ing] of a boot with a cowboy hat on top, with a lasso in the background and having ‘GiddyUp Boots’ on the top.”

Registration was also refused based on (now-cancelled) Reg. No. 4622499 for the mark GIDDYUP AUSTRALIA (in standard characters, “Australia” disclaimed) covering various articles of apparel, including hats and shirts. The registration was cancelled on May 21, 2021, during the prosecution of Applicant’s application, based on the registrant’s failure to file a Section 8 affidavit.

1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc'ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). We discuss these factors and the other relevant *DuPont* factors below.

As noted, the two cited registrations are owned by the same person and cover the same goods. We focus our analysis on the registered standard character mark, GIDDYUP BOOTS, because it does not contain the design elements, which may arguably serve as points of distinction with the applied-for mark. In other words, if it is ultimately decided that confusion is not likely between the standard character

mark and Applicant's proposed mark, we would also not find confusion likely with the registered composite mark. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Relatedness of the Goods; Trade Channels

Under the second and third *DuPont* factors, we consider, respectively, “[t]he similarity or dissimilarity and nature of the goods” and the “established, likely-to-continue channels of trade” for these goods. *DuPont*, 177 USPQ at 567. *See also Detroit Athletic*, 128 USPQ2d at 1051. For both factors, we must base our analyses on the identifications in Applicant's application and the cited registration. *See Stone Lion*, 110 USPQ2d at 1162; *In re Dixie Rests.*, 41 USPQ2d at 1534; *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The goods need not be identical for there to be a likelihood of confusion; there need only be a relationship in some manner, or the conditions surrounding their marketing are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *Coach Servs. Inc.*, 101 USPQ2d 1721; *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984).

Applicant admits in his appeal brief that the “[t]hird party registrations and website evidence submitted by the Examining Attorney during prosecution shows that the [Applicant's and Registrant's] goods (hats, shirts, boots) when broadly described in the application and cited registrations, are related and sold through the

same channels of trade.”³ Applicant further concedes that “this *DuPont* factor weighs in favor of a likelihood of confusion.”⁴

Independent of Applicant’s concessions, we agree that the evidence submitted by the Examining Attorney supports a showing of a relationship between Applicant’s shirts and hats, and Registrant’s boots, and that these goods may be found in the same trade channels. Specifically, she submitted evidence showing seven third-party online retailers offering boots and shirts/hats for sale the same mark.⁵ See *Detroit Athletic Co.*, 128 USPQ2d at 1050 (crediting relatedness evidence showing that third parties use the same mark for the goods and services); *In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009) (finding two third-party webpages showing applicant’s and registrant’s goods “can be manufactured and sold by a single source” supported relatedness); *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1640 (TTAB 2007) (evidence of three companies using single mark for clothing and fragrances supported finding of relatedness).

In addition, the Examining Attorney submitted copies of ten third-party registrations for marks that cover shirts and hats as well as boots.⁶ Third-party registrations that cover goods from both the cited registration and an applicant’s application are relevant to show that the goods are of a type that may emanate from a single source

³ 6 TTABVUE 18.

⁴ *Id.*

⁵ Printouts from third-party retail websites attached to July 30, 2020 Office Action, at TSDR pp. 10-18 and December 15, 2021 Reconsideration Office Action, at TSDR pp. 29-40.

⁶ Copies attached to December 15, 2021 Reconsideration Office Action, at TSDR pp. 2-28.

under one mark. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1051; *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Infinity Broad. Corp. of Dall.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel*, 29 USPQ2d 1785-86; *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

In sum, based on Applicant's concessions and the evidence submitted by the Examining Attorney, we find Applicant's and Registrant's goods are related and are the type of goods that may be offered in the same channels of trade by the same retailers. Accordingly, the second and third *DuPont* factors weigh in favor of finding a likelihood of confusion.

B. Similarity or Dissimilarity of the Marks

We now consider the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph*

Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1160; *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Although the marks must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See Stone Lion*, 110 USPQ2d at 1161 (finding that the Board did not err in reasoning that the term LION was dominant in both applicant’s mark STONE LION CAPITAL and opposer’s marks LION CAPITAL and LION); *Coach Servs.*, 101 USPQ2d at 1721; *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007).

In comparing Applicant’s JUST GYDDIUP and GIDDYUP BOOTS, we find them to be very similar in appearance, sound and commercial impression. The very similar terms GYDDIUP and GIDDYUP play a dominant role in the respective marks. The

transposition of the letters Y and I in the terms is hardly noticeable visibly, and the terms are likely to be pronounced identically because they will be recognized as the colloquial “command (as to a horse) to go ahead or go faster.”⁷ Applicant acknowledges this shared meaning, arguing that the two marks will be perceived in the following way:⁸

JUST GYDDIUP has a commercial impression and/or connotation of: ‘go really fast now!’; ‘move rapidly now!’ and/or ‘hurry up really fast now!’. The higher level of immediacy and intensity as conveyed in the commercial impression of JUST GYDDIUP is missing from the term GIDDYUP. GIDDYUP by itself does not convey any sense of a higher degree of immediacy and/or intensity like JUST GIDDYUP.

While the addition of JUST certainly precedes the command, we disagree with Applicant that it adds such a “higher level of intensity” that it distinguishes the marks and their connotations. The term “giddyup” (in either of its variant spellings) will be understood by consumers as an expression of the command to move faster. Adding the term JUST adds focus to this term, but not so much that it alters or creates a new commercial impression. For example, “move along” versus “just move along” or “hurry up!” versus “just hurry up!”—are essentially the same expressions.

Applicant argues, and submitted evidence in support, that “it has been common practice” by the Office to allow for the coexistence of registered marks in similar

⁷ Definition of “giddyap” (and variant “giddyup”) taken from online Merriam-Webster dictionary, submitted by Applicant. October 30, 2020 Request for Reconsideration, at TSDR p. 13.

Page references to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board’s TTABVUE docket system.

⁸ October 30, 2020 Request for Reconsideration, at TSDR p. 5.

situations—allowing one mark with the initial term JUST following by a word that is also registered by an unrelated entity for the same goods.⁹ Specifically, Applicant points to third-party registrations it submitted for the following marks (all covering various items of apparel):

1. JUST DEFEND coexisting with DEFEND OHIO, DEFEND USA, DEFEND JAPAN;¹⁰
2. JUST FUNKY coexisting with FUNKY JEANS and FUNKY SOCKS;¹¹
3. JUST CRAZY coexisting with CRAZY BRAND, CRAZY SHIRTS, and CRAZY SHORTS;¹²
4. JUST GYM coexisting with GYM BODY; and
5. JUST SWEAT! coexisting with SWEAT COLLECTIONS.

The evidence, however, has little probative value with respect to the question before us in this appeal—whether Applicant’s mark, JUST GYDDIUP, is confusingly similar to the registered mark, GIDDYUP BOOTS. The similarity of these marks depends on the relative strength of the shared or confusingly similar terms. The Board is not privy to the records of the registrations that Applicant relies upon, and thus we are not privy to information or evidence that may have influenced the decisions in their allowance, including, for example, possible consent agreements or evidence of weakness of the shared term based on extensive third-party use. That

⁹ August 13, 2020 Response, at TSDR p. 6 and pp. 12-56 (copies of third-party registrations).

¹⁰ Each of these registrations is owned by a different entity.

¹¹ Each of these registrations is owned by a different entity.

¹² The three registrations for the marks CRAZY BRAND, CRAZY SHIRT, and CRAZY SHORTS are owned by a common entity.

explains why the Board is not bound by decisions made in other applications. *See In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). *See also In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Each case must be decided on its own facts. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). In any event, the relatively few (5) occurrences hardly constitutes “common practice” by the Office. *See also In re Joel Embiid*, 2021 USPQ2d 577, at *38 (TTAB 2021) (third-party registrations pairs for COBRA and SOLE marks for clothing so different from the involved marks TRUST THE PROCESS “as to have no probative value”).

In this case, GIDDYUP and its variant convey the same connotation of equestrian or western wear for related wearing apparel, and that shared meaning is not dispelled by the addition of JUST. Aside from the now-cancelled registration for GIDDYUP AUSTRALIA (see Note 2), there is no evidence of other registered marks with the term GIDDYUP or similarly-spelled variant thereof.

Applicant also emphasizes that the now-cancelled GIDDYUP AUSTRALIA registration was originally cited by the Examining Attorney as a bar to registration of Applicant’s proposed mark, but that same registration did not prevent the GIDDYUP BOOTS (with and without design) marks from registering. Applicant contends that, as a matter of fairness, he applied-for mark should proceed to registration.¹³

Allowing a mark to register based on which examining attorney is examining the application is contrary to maintaining consistency among

¹³ 9 TTABVUE 4.

the examining corps. This is especially true when the law has not changed. If some examiners are more strict than other examining attorneys, the Board is uniquely positioned to correct inconsistencies when other JUST marks had been allowed, or when the GIDDYUP BOOTS marks had been allowed over GIDDYUP AUSTRALIA. The Board has the power to make the examining process fair among different examining attorneys especially when an examining attorney is outside the norm of what other examining attorneys have decided for similarly situated marks.

While the decisions to cite the now-cancelled GIDDYUP AUSTRALIA registration against Applicant but not Registrant may appear to be unfair, we reiterate that we cannot allow prior decisions of examining attorneys dictate a determination of likelihood of confusion in the instant appeal. *In re Nett Designs*, 57 USPQ2d 1564. Indeed, should an examining attorney ever make an error in examination, it would be wholly inappropriate to perpetuate such an error at the expense of avoiding confusingly similar marks and protecting the integrity of the U.S. trademark register. *Cf. In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017) (“to hold otherwise would essentially give binding effect to the decision of a Trademark Examining Attorney in granting Applicant’s prior registration.”)

As for the secondary term, BOOTS, in the registered mark, this is a point of difference between the marks, but it makes little difference in terms of distinguishing the marks. BOOTS has little to no source-identifying value because is generic for Applicant’s goods and has thus been appropriately disclaimed. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (finding the descriptive and disclaimed portions of applicant’s mark “unlikely to change the overall commercial impression engendered by the marks.”) (citing *Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-4 (Fed. Cir. 1997)); *see also In re Code Consultants, Inc.*,

60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”). Consumers encountering the registered mark GIDDYUP BOOTS on boots would focus on GIDDYUP as the primary or sole source-identifying feature of the mark.

Overall, we find that the marks in their entirety are very similar in appearance, sound, connotation and commercial impression. The first *DuPont* factor therefore weighs in favor of finding a likelihood of confusion.

C. Alleged Sophistication of Consumers for Registrant’s Goods

The fourth *DuPont* factor concerns the conditions under which and buyers to whom sales are made, i.e. “impulse” versus careful, sophisticated purchasing. *DuPont*, 177 USPQ at 567.

Applicant argues:¹⁴

The boots sold under GIDDYUP BOOTS as shown on Exhibit 20 are expensive at \$1800 or \$2000 for a pair. Each pair of boots sold under GIDDYUP BOOTS are couture, unique or one-of-a-kind. Each pair of boots is not mass produced and are hand-made. Hats and shirts sold under JUST GYDDIUP are inexpensive and a fraction of the price of the boots. These hats and shirts are/will be mass produced and machine-made.

...

In this case, this DuPont factor weighs in favor of Applicant because the consumers are sophisticated enough to understand that the source of the goods are different due to the price differential between the expensive, couture boots of GIDDYUP BOOTS and the inexpensive hats and shirts of JUST GIDDYUP.

Applicant’s arguments, however, are inappropriate because the registration’s identification of goods is “boots,” without any limitation. Similarly, Applicant’s shirts

¹⁴ 6 TTABVUE 12, 14.

and hats are not limited in any manner. Put simply, the identifications in the application and cited registration cover goods at no specified price points and are not restricted by age, fashion sense or sophistication. As discussed above, we look to the registration and application, and not to extrinsic evidence about Registrant's and Applicant's actual goods, customers, or channels of trade. See *Stone Lion*, 110 USPQ2d at 1161; *Octocom*, 16 USPQ2d at 1787 ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed."); *Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

Here, there is no evidence to suggest that either boots are always expensive,¹⁵ and shirts or hats clearly may range widely in price. We do not find that any the respective goods will only be purchased by sophisticated consumers exercising a higher degree of care. Rather, they may be purchased by ordinary and unsophisticated consumers. Our decision must be based on the "least sophisticated purchasers." *Stone Lion*, 110 USPQ2d at 1163.

Accordingly, this *DuPont* factor is neutral.

¹⁵ See, e.g., boots offered for sale at \$85. December 15, 2021 Reconsideration Office Action, at TSDR p. 32.

D. Balancing the *DuPont* Factors - Conclusion

Applicant's and Registrant's goods are related and are the types of goods that may be marketed through the same trade channels to some of the same classes of consumers. The marks in their entirety are very similar in overall appearance, sound, connotation and commercial impression. For these reasons, we find that Applicant's proposed mark JUST GYDDIUP for shirts and hats is likely to cause confusion with the registered standard character mark GIDDYUP BOOTS for boots.

Decision: The refusal to register Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is affirmed.